

REMARKS

Status of the Application

Claims 1-5 were pending in the application at the time the Office Action was mailed. Claims 1-5 were rejected. No claims were allowed. By this response, claims 1 and 2 have been amended. Support for the amendments to the claims can be found in FIGS. 1-4. New claims 6-10 have been added. Support for new claims 6-10 can be found in FIGS. 1-4. No claims have been canceled. Therefore, claims 1-10 are before the examiner for consideration.

Rejections Under 35 U.S.C. 102

Claims 1 and 3 were rejected under 35 U.S.C. 102(b) as being anticipated by Smith (US Patent No. 3,151,793). In particular, the Office Action states that:

Smith discloses a holder inherently capable of being a condiment container holder comprising a plurality of walls (12 and 13) each walls having a top lip (bend portion at top edge of wall 20, figure 4) on an upper portion thereof for retaining container (18), a bottom (11, figure 2) engaged to plurality of walls, the bottom having a bottom lip (16 and 17) on each end portion thereof and the bottom having a condiment well (26) formed therein inherently capable of receiving liquid condiment.

Because Smith fails to teach or suggest several limitations (structural differences) found in claim 1 as amended herein and claim 3 (which depends from claim 1), Smith does not anticipate claims 1 and 3. To anticipate a claim, the reference must teach every element of the claim (see MPEP 2131 and *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). The numerous structural differences that exist between the protective holder for sheet material of Smith and the claimed invention are described below.

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First, Smith does not teach a device having "...a first top lip disposed substantially perpendicular to the first wall and extending toward the second wall..." or "...a second top lip disposed substantially perpendicular to the second wall and extending toward the first wall..." as recited in amended claim 1. See, e.g., structures 16 and 18 of FIG. 2 of the present application. In comparison, the top edge of Smith's device shown in Fig. 4 is folded over to a position substantially parallel to its walls.

Second, Smith fails to teach or suggest a condiment container holder having a "bottom having a first end region forming a first bottom lip and a second end region forming a second bottom lip, each bottom lip being disposed substantially perpendicular to the remainder of the bottom." There are no bottom lips attached to or associated with the bottom of the receptacle of Smith, only walls. See column 1, lines 51-57, of Smith, which states that the receptacle "has a bottom wall 11 which has upstanding therefrom a front wall 12 and a back wall 13 which are substantially parallel to each other. Also upstanding from the bottom wall 11 are substantially parallel end walls 14 and 15..." Further, the four walls that are upstanding from the bottom wall of the receptacle of Smith are of similar heights. In the condiment container holder of the present invention, however, the bottom lips are significantly shorter than the plurality of walls. As recited in amended claim 1, "the first wall and the second wall are each taller than each bottom lip." The walls of the receptacle of Smith and the bottom lips of the present invention are thus different structures. Nowhere does Smith teach or suggest a bottom having a bottom lip on each end portion thereof, or on any portion thereof.

Third, Smith fails to disclose a condiment container holder having a "bottom having a condiment well formed therein, wherein the condiment well does not permit passage of a liquid therethrough" as recited in amended claim 1 and thus fails to disclose a condiment well that "is

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adapted to receive a liquid condiment” as recited in claim 3. As described in the present specification at page 7, lines 1-2, the condiment well in the preferred embodiment is “formed as a recess in bottom 24” so that “liquid condiments can be adequately contained.” In contrast, Smith teaches a receptacle having one or more apertures that are holes through which items such as screws and fingers (and of course liquids) can be passed. See column 2, lines 11-13, of Smith which state “[b]ack wall 13 of the receptacle has apertures 22 and 23 through which screws or nails can be placed to secure the holder to a vertical surface as shown in FIGURE 2.” Also see lines 19-20 of column 2 which state “[a] simple procedure is to insert a finger through the aperture when it is desired to remove the dispenser.” Clearly, the apertures of Smith are not condiment wells that do “not permit passage of a liquid therethrough” and they are not “adapted to receive a liquid condiment.” Applicants thus respectfully disagree with the Office Action on page 2 where it describes the holder of Smith as “having a condiment well (26) formed therein inherently capable of receiving liquid condiment.” The apertures of Smith are explicitly and obviously holes through which not only a liquid condiment can pass, but fingers and screws. A hole through which items can pass through and a well that does not permit passage of a liquid therethrough (that is adapted for containing a liquid) are clearly two *very different structures*.

Because Smith fails to disclose at least three structural elements of claims 1 and 3, withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. 103, Smith in view of Feerick

In the Office Action, claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Feerick (US Patent No. 2,491,652). In particular, the

Office Action states:

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Smith disclosed all the claimed features of applicant's invention except for a condiment container. Feerick teaches a holder supporting condiment containers (15). It would have been obvious to one of ordinary skill in the art to place condiment containers into the holder of Smith for holding condiments as taught to be desirably by Feerick.

Because the combination of references does not teach or suggest all the claim limitations present in claim 2 (which depends from amended claim 1), claim 2 is unobvious over the combination. To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Feerick fails to teach or suggest those structural limitations missing from Smith as described above.

In particular, like Smith, Feerick fails to teach or suggest a condiment container holder having a "...a first top lip disposed substantially perpendicular to the first wall and extending toward the second wall..." or "...a second top lip disposed substantially perpendicular to the second wall and extending toward the first wall...." Referring to FIGS. 1 and 3 of Feerick, rear walls 11 and 21, respectively, have no top lip attached to an upper portion thereof.

As with Smith, Feerick fails to teach or suggest a condiment container holder having a "bottom having a first end region forming a first bottom lip and a second end region forming a second bottom lip, each bottom lip being disposed substantially perpendicular to the remainder of the bottom." The base or shelf of the rack of Feerick, indicated by numerals 10, 22, and 30, does not have a bottom lip on each end portion thereof, or any portion thereof for that matter.

Further, Feerick fails to disclose a "bottom having a condiment well formed therein, wherein the condiment well does not permit passage of a liquid therethrough" as recited in claim 1. Although the rack of Feerick might possibly be able to support condiment holders, it does not have a bottom having a condiment well formed therein that is "formed as a recess in bottom 24"

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so that "liquid condiments can be adequately contained." In fact, if one were to place a sufficient volume of liquid condiment onto the base or shelf (see structures 10, 22, 30 of FIGS. 1, 3, and 4) of the rack of Feerick, the liquid condiment would run or spill out of the front of the rack.

As the combined teachings of Smith and Feerick do not teach or suggest all of the limitations of claim 2, the cited references do not render the subject matter of claim 2 obvious within the meaning of 35 U.S. C. 103. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. 103, Smith in view of Grondin

Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Grondin (US Patent No. 3,168,275). The Office Action further states:

Smith disclosed all the claimed features of applicant's invention except for using adhesive material for mounting to engage the bottom or wall. Smith uses fasteners to mount the holder. However, to substitute mounting fasteners with adhesives are notoriously old and well-known. Such modification has the known advantage of eliminating damage to a wall surface to which the holder is to be mounted. Grondin teaches a holder with walls (20) with lips (24) and bottom (18) engage the walls wherein releasable adhesive material (30, figure 2, 32, figure 3) can engage the bottom (18, figure 2) or the wall (20, figure 3) to alternatively mount the holder under different conditions. It would have been obvious to one of ordinary skilled in the art to substitute the mounting fasteners of Smith with releasable adhesive as taught by Grondin to prevent damage to a wall surface and to provide the adhesive material at either the bottom or wall as taught by Grondin to facilitate alternative mounting under different orientation.

Because the combination of references does not teach or suggest all the claim limitations present in claims 4 and 5 (which depend from amended claim 1)¹, the combination of references does not render the present invention obvious within the meaning of 35 U.S. C. 103. Neither reference

¹ To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).
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teaches or suggests a condiment container holder having a bottom "having a first end region forming a first bottom lip and a second end region forming a second bottom lip, each bottom lip being disposed substantially perpendicular to the remainder of the bottom," or "having a condiment well formed therein, wherein the condiment well does not permit passage of a liquid therethrough" as recited in amended claim 1 from which claims 4 and 5 depend. Moreover, the combination of the devices described in Smith and Grondin would result in a holder that was inoperative for the purposes of the presently claimed invention because a device having the end walls (walls 14, FIG. 1) of Smith and the front walls (walls 24, FIG. 1) of Grondin would physically occlude the insertion of a condiment container into the device and further, the device would not have a bottom having a condiment well formed therein. There is no suggestion to modify a prior art device where the modifications would render the device inoperable for its intended purpose. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

As the combined teachings of Smith and Grondin do not teach or suggest all the limitations of claims 4 and 5, the cited references do not render the present invention obvious within the meaning of 35 U.S. C. 103. Accordingly, withdrawal of these rejections is respectfully requested.

Conclusion

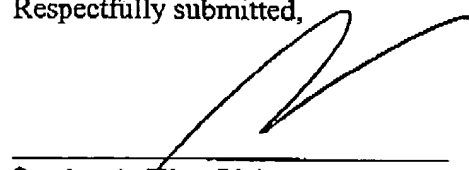
The currently pending claims before the examiner are supported throughout the specification and are patentable over the prior art. No new matter has been added. This application is now in full condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any underpayment or credit any overpayment of fees under 37 CFR 1.16 or 1.17 as required by this paper to Deposit Account 50-3110. This response is accompanied by a retroactive petition for a one month extension of time and the required fee.

The examiner is cordially invited to call the undersigned if clarification is needed on any matter within this amendment, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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